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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,455	03/14/2001	Weiniu Gan.	CL001165	9755

25748 7590 02/20/2003

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT PAPER NUMBER

1634

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/805,455

Applicant(s)

GAN ET AL.

Examiner

Jeffrey Fredman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 4,8,9,13 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 4,8,9 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group III, claims 4-6, 8, 9, 22 and 23 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that examination of claim 13, in Group VII would not represent a burden. This is not found persuasive because the claim would require separate search and consideration with regard to both the prior art and with regard to issues of enablement, description and definiteness. Proof of the burden required is shown by the separate classification of the groups, which is prima facie evidence of burden which has not been rebutted.

Newly submitted claim 24 is directed to an invention that is independent or distinct from the invention originally claimed because it would fall within Group V of the restriction, which Group was not elected. Accordingly, claim 24 is withdrawn from consideration as being directed to a non-elected invention.

However, should the product claims be found allowable, the examiner will consider rejoining these two claims, if they remain dependent upon the product claims, as per the procedure under MPEP 821.04.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see page 13, for example). Applicant is required

to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 4, 8, 9, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Guru et al (Genome Research (1997) 7:725-735).

Guru teaches Bac clone 137c7, deposited in Genbank as Accession No. AC000134. This Bac comprises a genomic sequence which encodes a protein comprising the sequence of SEQ ID NO: 2, including the amino acids AIPLPA which are absent in the related protein at nucleotides 78,990 to nucleotide 78,972 (see printout of AC000134). Further, this sequence is in a BAC vector which are grown in bacterial host cells (see page 733, subheading "genomic clone sequencing"). Since this sequence is the genomic sequence of the protein, it is inherently operatively linked to the native promoter sequence for the protein. The Bac clones were then subjected to shotgun sequencing, in which the sequences were placed into plasmid vectors in bacterial host cells (see page 733, subheading "genomic clone sequencing").

***Allowable Subject Matter***

5. Claim 25 and 26 are allowed.

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6. The following is a statement of reasons for the indication of allowable subject matter: Claims 25 and 26 are drawn to isolated sequences with closed claims. The genomic sequence does not comprise or teach the cDNA sequence of SEQ ID NO: 1 in claim 25. While the Bac comprises the genomic sequence claimed in claim 26 of SEQ ID NO: 3, the Bac is significantly larger and there is no suggestion that the particular genomic sequence of claim 26 should be separated from the larger Bac sequence.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is 703-308-6568. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jeffrey Fredman  
Primary Examiner  
Art Unit 1637

February 12, 2003